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Docket No.: FL1049USPCT

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REMARKS**Summary**

Claims 1-11 of the application were rejected as obvious under 35 USC 103(a) based on the combined disclosures of WO 97/03936 and EP-A-0626362.

Claim 12 of the application was rejected as obvious under 35 USC 103(a), based on the above combined disclosures, further in light of JP 07291878.

Applicants respectfully traverse these rejections and request that the application be allowed.

Argument

The combination of the '936 and '362 publications is improper. WO 97/03936 is not prior art to the instant application as defined under 35 USC 102 except under §102(e). However, under §103(c)1, prior art that qualifies under §102(e) cannot form the basis for unpatentability when the art and application are both jointly owned.

Since the instant claims are only obvious in light of the combined disclosures which include the '936 application by necessity, and the '936 application cannot form the basis for unpatentability, applicant submits that the rejection must be withdrawn and the application allowed to issue.

First, the '936 publication is not prior art to the instant application under §102(a). Applicant submits that the date of invention of the instant application pre-dates the publication date of the '936 publication. An affidavit on this point will follow this submission.

Second, the '936 publication is not prior art under §102(b). For a foreign publication to be prior art under §102(b), it must be published more than one year before the priority date of the instant application. Here, the priority date of the instant application is August 12, 1997. The publication date of the '936 reference is February 6, 1997, well within the 1 year grace period.

Third, §102(c) and §102(d) are inapplicable, as 1) applicant has not abandoned the present application and 2) applicants have not filed for a patent on this invention abroad more than one year before the filing date of the application.

Technically the reference does not qualify under §102(e)(1), as it is not a publication published under §122, nor under §102(e)2 as it is merely a printed publication of an international patent application. However, a member of the '936

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applications patent family, US Patent 6,156,161 did issue in the United States and is based on the same priority document as the '936 application, provisional application 60/001,156 filed July 14, 1995. This document has not been cited against the present application. However, under §102(e)2, the '161 patent would count as prior art but for operation of §103(c)1. For the sake of consistency and clarity, rather than refer now to the '161 US Patent, Applicants will continue to refer to the '936 reference. The disclosures of both are identical, and again, the '161 Patent would qualify as prior art but for operation of §103(c)1.

Regardless, by operation of §103(c)1, the disclosure of the '936 patent (or the '161 patent) cannot be the basis for unpatentability of the instant claims.

In relevant part, 35 USC 103(c)1 states: (c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicant submits that at all relevant times, the '936 reference, its '161 Patent counterpart and the instant application have all been jointly owned by operation of the inventors respective assignments, all of record and on file with the USPTO, to E.I. du Pont de Nemours and Company.

In short, the '936 reference is not prior art to the instant application and cannot for the basis of invalidity under §103(a) by operation of §103(c)1.

Given that the entirety of the rejection of claims 1-11 is based on the combination of the '362 patent with the '936 reference, and the '936 reference by operation of statute cannot be used in this combination, Applicants requests that this rejection be withdrawn and the application be allowed.

Given that the entirety of the rejection of claim 12 is based on the combination of the '936 reference with JP'878 and the '362 patent, and the '936 reference by operation of statute cannot be used in this combination, Applicants request that this rejection be withdrawn and the application be allowed.

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In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Respectfully submitted,



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